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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,346	12/01/2000	Richard G. Sheehan	9518-001-99	1857

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DLA PIPER US LLP
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WASHINGTON, DC 20036

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/726,346	SHEEHAN ET AL.	
	Examiner	Art Unit	
	Stefano Karmis	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8,10-23,25,27-38 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,10-23,25,27-38 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>12/2/05</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 03 November 2005.

Status of Claims

2. Claims 1-4, 8, 10-23, 25, 27-38 and 41-44 are currently pending.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4, 8, 10-23, 25, 27-38 and 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear how the received data in step (A) for determining a sample size correlates to the steps of (B)-(C) for performing the retention rate calculations. There is no link between steps (A) and steps (B)-(C) and therefore (A) appears to be non-functional descriptive material.

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Regarding claim 19, step (H) states the data for each of the plurality of “financial assets” however steps (A)-(C) have been amended to state “balance sheet items” instead of “financial assets.”

Claims 2-4, 8, 10-18, 20-23, 25, 27-38 and 41-44 stand rejected for similar reasons or based on their dependency. Therefore 1-4, 8, 10-23, 25, 27-38 and 41-44 stand rejected because Applicant has failed to particularly point out and distinctly claim the subject matter regarded as the invention.

Claim Rejections - 35 USC § 101

6. Claims 1-4, 8, 10-18, 20-23, 25, 27-37, 42 and 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1-4, 8, 10-17, 20-23, 25, 27-37, 42 and 44, the Examiner finds these claims to lack a tangible result. In order to be a tangible result, the process must produce a real-world result. The final step of independent claim 1 states, “combining said first and second retention rate to determine a predicted useful life of the combined plurality of balance sheet items.” This step does not actually output the predicted useful life to a user or record it in a database, and therefore there is no tangible result.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 20-23, 25, 27-29 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luskin et al. (hereinafter Luskin) 6,336,102 in view of Atkins, U.S. Patent 5,875,437.

Regarding claim 20, Luskin teaches a method for determining useful life of a financial asset comprising a factor of rates that are keyed to the time horizon of a fund (column 2, lines 24-47). Luskin further teaches market data including interest rates in combination with cash flow to determine present value (column 6, line 45-53). Luskin fails to teach combining two rates for a financial calculation. Atkins teaches combining fixed and floating rates to aid in determining a balance of a loan over different time horizons (column 37, lines 47-67). Atkins further teaches considerations such as net income and dividends when calculating information which are used in retention rate determination (column 14, lines 45-65 and column 27, line 53

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thru column 28, line 67). It would have been obvious to one of ordinary skill in the art that the teachings of Luskin could have been modified to include the teachings of Atkins because provides information needed used to determine various rates which can be used in time horizon determinations and it provides an efficient data for determining a factor of a financial instrument such as useful life as well as provide information needed used to determine various rates which can be used in time horizon determinations.

Claim 21, selecting one of a plurality of variables affecting at least one of the retention rates (column 6, line 45-53).

Claim 22, Luskin fails to teach determining sensitivity. Official Notice is taken that determining sensitivity is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art to determine sensitivity because it provides various possible outcomes and thus provides more reliable information.

Claim 23, Luskin teaches the ability to forecast scenarios using market data (column 6, lines 54-65).

Claims 25, 27 and 28, the financial assets comprise deposits, financial instruments or a combination thereof (column 2, lines 38-63).

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Claim 29, Luskin fails to specify the length of the time frame. Official Notice is taken that time frames for financial data are old and well known in the art. It would have been obvious of one of ordinary skill in the art to provide a time line of 4 years because it provides an efficient time frame to recover and process information to determine trends with financial data.

Claims 31 and 32, Luskin fails to teach checking for outliers and exogenous variables. Official Notice is taken that validating calculations is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to modify the teachings of Luskin to include determining outliers and exogenous variables because it provides an efficient manner to assist in validating financial calculations.

Claims 33 and 34, Luskin teaches to include interest rate calculations as one of the calculations (column 6, lines 46-53).

Claims 35 and 36, the forecasting scenarios includes providing future values for use in calculations (column 4, lines 26-35 and column 6, lines 46-65).

Claim 37, outputting the predicted useful life of the combined assets (column 7, lines 17-25).

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Allowable Subject Matter

11. Claims 1-4, 8, 10-17, 30 and 41-44 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 101, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
Stefano Karmis
28 November 2006

